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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,937	09/12/2003	Robert M. Gorday	PT03585U	7030
20280	7590	08/21/2007	EXAMINER	
MOTOROLA INC			DUONG, FRANK	
600 NORTH US HIGHWAY 45			ART UNIT	
ROOM AS437			PAPER NUMBER	
LIBERTYVILLE, IL 60048-5343			2616	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,937

Applicant(s)

GORDAY ET AL.

Examiner

Frank Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-31 and 40 is/are rejected.
- 7) ☒ Claim(s) 4-11 and 32-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is a response to communications dated 09/12/03. Claims 1-40 are pending in the application.

Information Disclosure Statement

2. The information disclosure statement filed 09/12/03 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP §.609. It has been considered and placed in the application file.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

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- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The disclosure is objected to because of the following informalities: BRIEF SUMMARY OF THE INVENTION is required. Examiner understands that describing the "invention" as having certain attributes can limit claim scope. See *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 864 (Fed. Cir. 2004). However, the USPTO guidelines clearly set forth that all of the US patent application specifications ought to follow the above guidelines to benefit the patent community should this application become a patent. Thus, BRIEF SUMMARY OF THE INVENTION is still required.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 12-31 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al (USP 5,742,905) (hereinafter "Pepe").

As per **claim 1**, in accordance with Pepe reference entirety, Pepe discloses a method of selection of a mixed media communication format at a portable

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communication device (*Fig. 1; element 30, 32 or 34 and the description at col. 3, lines 45-48*) comprising:

determining (registering), by the portable communication device, a preferred format (CallCommand or wireless messaging service) for an incoming call from mixed media communication formats (*at col. 17, lines 13-17 and thereafter, Pepe discloses PDA 30 registers with PCI server 48 for either CallCommand or wireless messaging services*), the mixed media communication formats including a text format and an audible speech format (*col. 23, lines 40-42*); and

sending (uploading), by the portable communication device, a media format mode signal (*subscriber's profile*) indicating the preferred format for the incoming call (*subscriber's profile management is discussed at col. 21, lines 64-67. In addition, at col. 22, lines 32-62, Pepe also discloses uploading subscriber's profile having direction from the subscriber of how to handle an incoming call to the PCI server 48*).

As per **claims 2-3**, in addition to features recited in base claim 1 (see rationales discussed above), Pepe further discloses wherein determining determines the preferred format for the incoming call based on location conditions of the portable communication device (*at col. 25, lines 25-39, Pepe discloses subscriber's profile stored in PCI database 44 telling the PCI server 44 how to handle the incoming message based on subscriber's location conditions (home and office) or subscriber's radio coverage is discussed at col. 27, line 9 and thereafter*).

As per **claim 12**, in addition to features recited in base claim 1 (see rationales

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discussed above), Pepe further discloses wherein determining determines the format for the incoming call to be a text format based on a silent mode (program) selected by the user of the portable communication device (*col. 25, line 51 to col. 26, line 9, Pepe discloses subscriber can program the profile to have e-mail (text format) to be sent to subscriber PDA 30*).

As per **claim 13**, in addition to features recited in base claim 1 (see rationales discussed above), Pepe further discloses wherein determining determines the preferred format for the incoming call based on a user input of media format selection data (*col. 25, line 51 to col. 26, line 9, Pepe discloses subscriber can program the profile to have e-mail (text format) to be sent to subscriber PDA 30*).

As per **claim 14**, in addition to features recited in base claim 1 (see rationales discussed above), Pepe further discloses displaying a current media format mode on the portable communication device, the current media format mode including at least one of a current media format input mode and a current media format output mode (*col. 29, line 65 to col. 30, line 13 and thereafter, Pepe discloses CallCommand enabling nomadic subscriber to manage incoming calls using screening, rerouting and messaging to the caller. CallCommand screen to include incoming call and outgoing call (forwarded call) are depicted in Fig. 31*).

As per **claim 15**, in accordance with Pepe reference entirety, Pepe discloses a method (Fig. 24 and col. 30, lines 28-56) of selection of a mixed media communication format at a portable communication device (30, 32 or 34) when receiving a signal of an incoming call, the mixed media communication format including an audio

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communication format and a text communication format (*col. 23, lines 40-42*), the method comprising:

receiving, by the portable communication device, a signal of an incoming call (*col. 30, lines 40-41, Pepe discloses subscriber Mary is notified of an incoming call*);

determining, by the portable communication device, a preferred format of the incoming call (*col. 30, lines 45-55, Pepe discloses Mary selects a preferred mode to receive the call*); and

sending, by the portable communication device, a media format mode signal indicating the preferred format for the incoming call (*col. 30, lines 45-55, Pepe discloses Mary sends the PCI network her preferred mode of receiving it*).

As per **claim 16**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe further discloses storing the preferred format for an incoming call on the portable communication device (*downloading profile to PDA 30 is discussed at col. 22, lines 5-7 and thereafter*).

As per **claim 17**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe further discloses accepting a user input of media format selection data of a preferred communication format and transmitting the media format selection data to a communication system (*Mary's call treatment sent to PCI network is discussed at col. 30, lines 45-55*).

As per **claim 18**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe further discloses displaying a current media format mode on the portable communication device, the current media format mode including at least

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one of a current media format input mode and a current media format output mode (*Fig. 31 depicts CallCommand screen*).

As per **claim 19**, in accordance with Pepe reference entirety, Pepe shows a system for the selection of a mixed media communication format comprising:

a network (Fig. 4); and

a controller (Fig. 4; element 48) coupled to the network (*see Fig. 4 for connection details*), the controller configured to determine the format of a call from a call originator, to determine a selected format of the call for a call recipient based on selection conditions of the call recipient, to convert the format of the call to the selected format when the format of the call from the call originator does not match the selected call format of the call for the call recipient, and to send the call in the selected format to the call recipient (*PCI Server 48 and its functionalities are discussed at col. 8, line 31 to col. 17, line 11 and thereafter to include how to handle incoming call based on subscriber's profile as well as converting text to speech or vice versa*).

As per **claim 20**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller converts the format of the call by sending a media format negotiation signal to the call originator to prompt the call originator to change the format of the call based on the selected format (*col. 31, lines 14-65*).

As per **claim 21**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller is further configured to determine the format of the call based on a call recipient communication device

capability of supporting specific types of media (*col. 32, lines 48-67*).

As per **claim 22**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller is further configured to determine the format for the incoming call based on a current system capacity (*col. 32, lines 46-47*).

As per **claim 23**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses PCI server 48 also translates the wireless text message into speech and plays it back to the caller.

As per **claim 24**, the sending of background noise or comfort noise while a mobile waiting for a response is inherent in wireless communication system. This is a practical way to inform a subscriber that the system is functioning normally.

As per **claim 25**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses PCI server 48 also translates the wireless text message into speech and plays it back to the caller. This also holds true for converting the text message into an audio or voice message should the subscriber choose the audio or speech as a preferred format for receiving the incoming call.

As per **claims 26-27**, the predetermined call command options are discussed at col. 31, lines 22-65. This feature allows a subscriber to have the calls to be properly routed.

As per **claim 28**, a call messaging option is discussed at col. 31, lines 5-21 to include informing the calling party should the call cannot be made at that moment.

As per **claims 29-31 and 40**, the claims call for a device comprising elements

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that mirror method steps of claims 1-3 and 12, respectively. Thus, they are anticipated for the same rationales discussed above.

Allowable Subject Matter

5. Claims 4-11 and 32-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, considered individually or in combination, fails to fairly show or suggest the claimed invention of base claims and further limit with novel and unobvious limitation of location conditions to include velocity and a plurality of co-located of portable communication devices, structurally and functionally interconnected with other limitations in a manner as recited in claims 4-11 and 32-39.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hiri (USP 6,490,550).

Warnock et al (USP 6,151,576).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



FRANK DUONG
PRIMARY EXAMINER

August 16, 2007